

REMARKS

Drawings

Paragraph 3 of the Action requests that the legend – Prior Art – be added to Figures 1 and 2. Applicant has updated Figures 1 and 2 to incorporate the requested legend. New figures 1 and 2 are attached, as are marked up copies showing the addition of the legend to the figures.

Claim Rejections Under § 102

Paragraph 4 of the Action rejects claims 1, 5, 9, and 13 under 35 U.S.C. 102(b) as being unpatentable in view of Davis (U.S. Patent 5,877,724). Claims 1, 5, 9, and 13 have been amended in the above amendments to ultimately depend from independent claim 40, which as explained below, Applicant believes is allowable over the art of record. Thus, Applicant respectfully requests withdrawal of the rejection as to amended claims 1, 5, 9, and 13 because they depend from independent claim 40, which is itself allowable over the art of record.

Paragraph 5 of the Action rejects independent claim 40 under 35 U.S.C. 102(b) as being unpatentable in view of Soliman '229 (U.S. Patent 6,081,229). Applicant respectfully traverses the rejection because Soliman '229 fails to teach, suggest, or disclose every element of independent claim 40. In order for independent claim 40 to be anticipated by Soliman '229, Soliman '229 must teach each and every element as set forth in independent claim 40 (see MPEP § 2131). Moreover, Soliman '229 must teach the identical invention in as much detail as is contained in independent claim 40 (see MPEP § 2131).

Claim 40 is directed to:

A wireless communication device, comprising:

a wireless communication transceiver configured to allow the wireless communication device to interface with a wireless communication network; and

a GPS receiver configured to receive GPS signals, the wireless communication device configured to act as a standalone GPS receiver or to act as a network assisted GPS receiver *when it is determined that network assistance is available from the wireless communication network.*

Paragraph 5 of the Action, citing to the “Summary of the Invention,” states that Soliman ‘229 discloses a wireless transceiver that can act as a standalone GPS receiver, or as a network assisted GPS receiver when it is determined that network assistance is available; however, the specification of Soliman ‘229, including the summary, does not disclose the step of determining whether *network assistance is available from the wireless communication network*, and either acting as a standalone GPS receiver or as a network assisted GPS receiver depending on the determination.

Rather, Soliman ‘229 discloses a method of network assisted GPS whereby a wireless communication device determines its position using ranging information provided by a network, timing information provided by the wireless communication device, and ranging information provided by GPS satellites (see col. 2, lines 17-36). The only variation disclosed, regarding the above approach for position determination taught in Soliman ‘229, is the case where there is a line-of-site signal from the base station to the wireless communication device. In such cases, Soliman ‘229 discloses that fewer GPS satellite signals are required to make the position determination (see col. 3, lines 11-18).

The entire detailed description included in Soliman '229 is devoted to explaining the above two approaches to network assisted GPS position determination. Thus, Soliman '229 teaches two modes of network assisted GPS position determination. The Action correctly points out that the summary indicates there are potentially 5 modes of operation for a wireless communication device configured according to the teachings of Soliman '229 (see col. 3, 55-63); however, Applicant can only assume that the five listed modes are variations of the two network assisted modes described above, as no definition or description of any other modes is provided anywhere in the specification.

Moreover, regardless of how the five listed modes are defined, Soliman '226 still does not teach, suggest, or disclose first determining if network assistance is available and then selecting a mode of operation (see paragraph 10 of the Action and Applicant's response below).

Accordingly, Soliman '229 cannot anticipate independent claim 40 because Soliman '229 fails to teach, suggest, or disclose every element of independent claim 40 in the same detail as that provided by claim 40. Applicant, therefore, respectfully requests withdrawal of the rejection of claim 40.

Claim Rejections Under § 103

Paragraphs 6 and 7 of the Action reject claims 3 and 11 under 35 U.S.C. 103(a) as being unpatentable in view of various combinations of Soliman '229 and Davis. Claims 3 and 11 have been amended in the above amendments to ultimately depend from independent claim 40. Thus, Applicant respectfully requests withdrawal of the rejection as to amended claims 3 and 11 because they depend from independent claim 40, which is itself allowable over the art of record.

Paragraph 8 of the Action rejects claims 4, 12, and 24-26 under 35 U.S.C. 103(a) as being unpatentable in view of Davis and in further view of Krasner '960 (U.S. Patent 6,107,960).

Claims 4, 12, and 24-26 have been amended in the above amendments to ultimately depend from independent claim 40. Thus, Applicant respectfully requests withdrawal of the rejection as to amended claims 4, 12, and 24-26 because they depend from independent claim 40, which is itself allowable over the art of record.

Paragraph 9 of the Action rejects claims 4, 12, and 20-39 under 35 U.S.C. 103(a) as being unpatentable in view of Davis and in further view of Krasner '944 (U.S. Patent 5,945,960). Claims 4, 12, and 20-39 have been amended in the above amendments to ultimately depend from independent claim 40. Thus, Applicant respectfully requests withdrawal of the rejection as to amended claims 4, 12, and 20-39 because they depend from independent claim 40, which is itself allowable over the art of record.

Paragraph 10 of the Action rejects claims 14-19 under 35 U.S.C. 103(a) as being unpatentable in view of Soliman '229 and in further view of Krasner '960. Claims 14-16 ultimately depend from independent claim 40. Thus, Applicant respectfully requests withdrawal of the rejection as to claims 14-16 because they depend from independent claim 40, which is itself allowable over the art of record.

With regard to independent claim 17, Applicant traverses this rejection because Soliman '229 and Krasner '944 fail to teach, suggest, or disclose every element of the claim. In order to sustain a *prima facie* case of obviousness, Soliman '229 and Krasner '944 must teach or suggest every claim limitation and also a reasonable expectation that the claimed combination will be successful (see MPEP §2141.03).

The previous Action asserted a similar rejection over the combination of Krasner '960 and Krasner '944. In response to that rejection, Applicant stated that neither Krasner '960, nor Krasner '944 can possibly teach, suggest, or disclose first checking to see if network assistance is

available and then either configuring the wireless communication device to act as standalone GPS processor or as a network assisted GPS processor depending on whether the network assistance is available. As a result, neither Krasner '960, nor Krasner '944, alone or in combination can support a *prima facie* case of obviousness with regard to claims 17-19.

The Current Action asserts that Soliman '229 provides the missing disclosure that teaches determining if network assistance is available and then either configuring the wireless communication device to act as standalone GPS processor or as a network assisted GPS processor depending on whether the network assistance is available; however, as explained above in regard to claim 40, Soliman '229 does not teach, disclose, or suggest determining if network assistance is available and then either configuring the wireless communication device to act as standalone GPS processor or as a network assisted GPS processor depending on whether the network assistance is available.

The Action states that since both modes are available, it would have been obvious to use assistance information if it is available in order to speed up position determination and reduce power consumption. Applicant must respectfully disagree. First, no reference is provided to support such an assertion. In fact, none of the references cited in either action teach having standalone GPS receiving and network assisted receiving capabilities available to be selected as required. Again, while Soliman '229 indicates that there are five possible modes, nowhere does Soliman '229 teach that they can be available to be selected as required. Further, as explained above, Applicant can only assume that the five listed modes are in fact variations of the two network assisted modes described above, as no definition or description of any other modes is provided anywhere in the specification.

Second, contrary to what is asserted by the Current Action, Applicant believes that determining if network assistance is available and then either configuring the wireless communication device to act as standalone GPS processor or as a network assisted GPS processor depending on whether the network assistance is available is not obvious as evidenced by the fact that not one of the references cited in either action teaches these steps.

Accordingly, neither Soliman '229 nor Krasner '944, alone or in combination, teach or suggest every claim limitation of independent claim 17. Nor do they teach a reasonable expectation that the claimed combination will be successful. Applicant, therefore, respectfully requests withdrawal of the rejection as to claim 17. Applicant further respectfully request withdrawal of the rejection as to claims 18 and 19, because they depend from claim 17, which is itself allowable over the art of record.

Miscellaneous Claim Amendments

Due to the claim amendments described above, several miscellaneous claim amendments were required to maintain consistency between the claims as well as between the claim language and terms. In making these miscellaneous claim amendments, Applicant believes that no new matter was added.

CONCLUSION

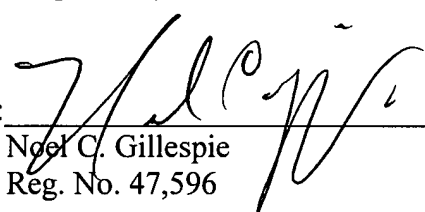
Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested.

After the above Amendments, claims 1, 3-5, 9, and 11-40 are still pending in the application. Applicant believes that no fees are necessitated by this action; however, the Commissioner is hereby authorized to charge any fees required by this response to our Deposit Account No. **50-2613** (Order No. 37945.00012.UTL1).

Respectfully Submitted,

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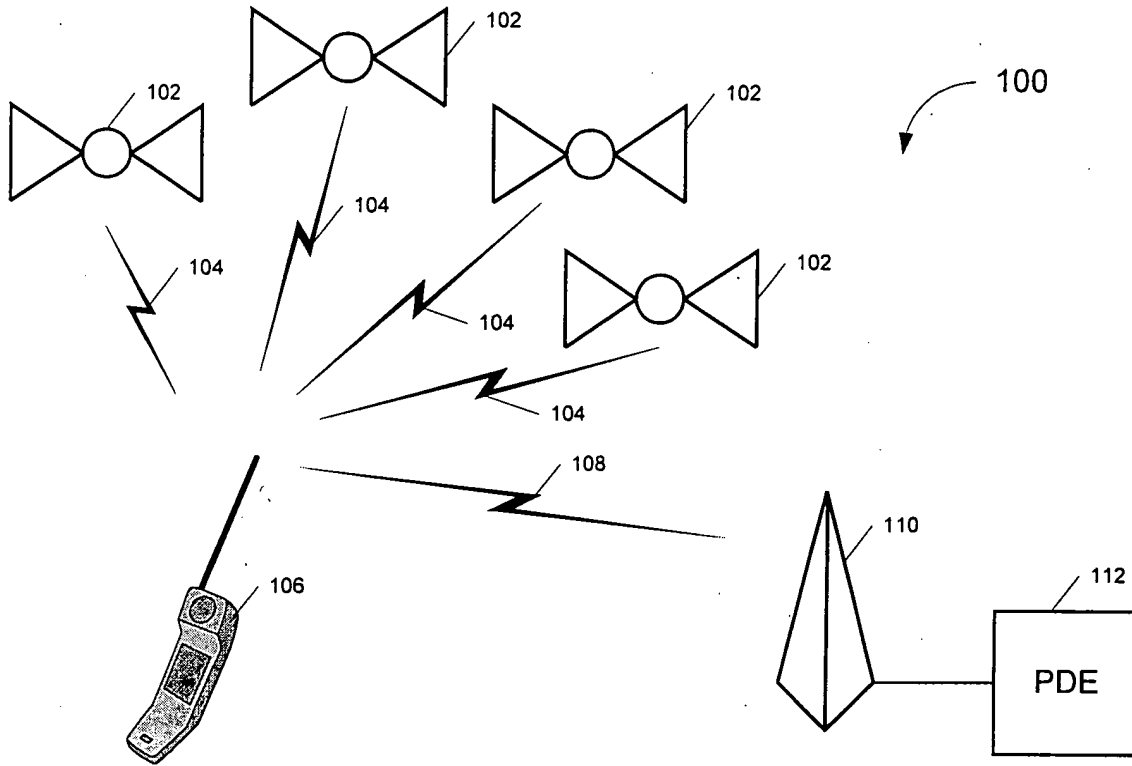


Figure 1
(PRIOR ART)

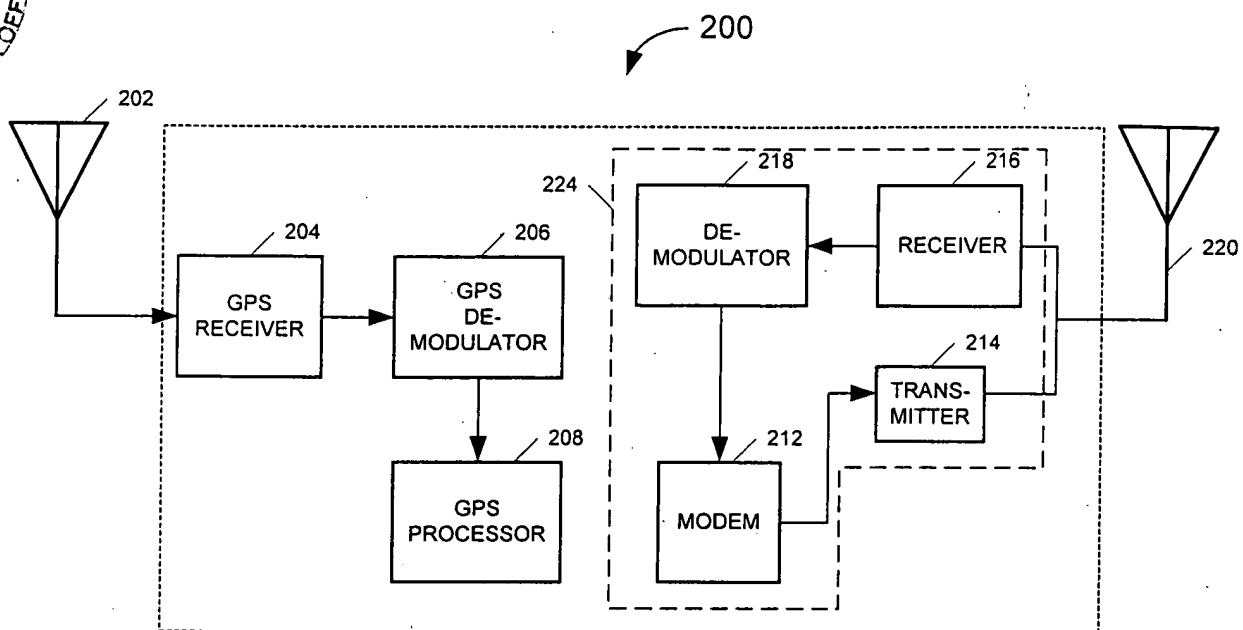


Figure 2
(PRIOR ART)